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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,373	01/12/2005	Timothy Bateman	0119/0036	4686

21395 7590 05/03/2005

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EXAMINER

PATEL, MITAL B

ART UNIT PAPER NUMBER

3743

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,373

Applicant(s)

BATEMAN ET AL.

Examiner

Mital B. Patel

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 12 is/are rejected.
- 7) ☒ Claim(s) 7 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. Claims 10 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10 and 12 improperly positively claim a part of the human body. The Examiner suggests the following language for both claims, --an adhesive extending around its edge **adapted to** contact the user's skin.--

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudolph (US 5,265,595).

4. **As to claim 1**, Rudolph teaches a mask apparatus including a generally ring shape sealing assembly **5** adapted to be retained with the head and to seal around at least a mouth of a user, and a gas inlet (**See Figs. 2 and 3, Col. 5, lines 47-66**) for supplying gas to the apparatus, characterized in that the sealing assembly has a central opening **50** located in the region of the mouth, and a removable closure **6** for securing with the central opening and the gas inlet is mounted with the closure.

Art Unit: 3743

5. **As to claim 2**, Rudolph teaches a mask apparatus characterized in that the closure includes a plate **71**.
6. **As to claim 4**, Rudolph teaches a mask apparatus characterized in that the closure is a push fit in the central opening (**Col. 5, lines 47-66**).
7. **As to claim 5**, Rudolph teaches a mask apparatus characterized in that the sealing assembly includes a shelf **27** adapted to extend beneath the nose of the user.
8. **As to claim 6**, Rudolph teaches a mask apparatus characterized in that the shelf supports a compliant substance (**that which forms 5**) adapted to seal the nostrils.
9. **As to claim 8**, Rudolph teaches a mask apparatus characterized in that the apparatus includes a harness **10,11,12** secured with the sealing assembly and adapted to extend around the head of the user.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3743

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph (US 5,265,595).

14. **As to claim 3**, Rudolph teaches essentially all of the limitations except for wherein the plate is curved. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the plate curved because Applicant has not disclosed that a curved plate provides an advantage, is used for a particular purpose, solves a stated problem, or provides unexpected results over that of any other shape. One of ordinary skill in the art, furthermore, would have expected Rudolph's plate, and applicant's invention, to perform equally well with the shape of the plate as taught by Rudolph or the claimed curved plate because both plates would perform the same function of securing the closure to the sealing assembly. Therefore, it would have been prima facie obvious to modify Rudolph to obtain the invention as specified in claim 3 because such a modification would have been

Art Unit: 3743

considered a mere design consideration which fails to patentably distinguish over the prior art of Rudolph.

15. **As to claim 9**, Rudolph teaches essentially all of the limitations except for specifics of the recited harness. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the harness as recited because Applicant has not disclosed that the recited harness provides an advantage, is used for a particular purpose, solves a stated problem, or provides unexpected results over that of any other harness. One of ordinary skill in the art, furthermore, would have expected Rudolph's harness, and applicant's invention, to perform equally well with the harness as taught by Rudolph or the claimed harness because both harnesses would perform the same function of securing the mask apparatus to the user. Therefore, it would have been prima facie obvious to modify Rudolph to obtain the invention as specified in claim 9 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Rudolph. Furthermore, the use of the recited harness is known in the art.

16. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph (US 5,265,595) in view of Kaimer (US 5,143,061).

17. **As to claims 10 and 12**, Rudolph teaches essentially all of the limitations except for wherein the sealing assembly includes an adhesive extending around its edge to contact the user's skin. However, Kaimer does teach the use of an adhesive on a sealing assembly for a mask to provide a supplemental seal to prevent leakage of a

Art Unit: 3743

gas. Therefore, it would have been obvious to one of ordinary skill in the art to provide adhesive on the sealing assembly edge so that a supplemental seal is provided to prevent leakage of a gas that is supplied to the user.

Allowable Subject Matter

18. Claims 7 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor render obvious the overall claimed combination of a mask apparatus characterized in that the shelf has a passage therethrough adapted to supply gas to the user's nose. It should be noted the closest prior art of record is to Rudolph (US 5,265,595). However, Rudolph teaches away from supplying gas to the user's nose and therefore, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the Rudolph reference to arrive at the limitations of claims 7 and 11.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6796308, US 6467483, US 6412488, US 6397847, US 6192886, US 6082360, US 5758642, and US 5538001.

Art Unit: 3743

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 571-272-4802. The examiner can normally be reached on Monday-Friday (11:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5/1/05
Mital B. Patel
Examiner
Art Unit 3743